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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,949	09/26/2003	Jamie Marie Davis	PC25413A	9410

28880 7590 07/07/2006

WARNER-LAMBERT COMPANY
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ANN ARBOR, MI 48105

EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,949

Applicant(s)

DAVIS ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

In view of applicants' response filed 4/26/06 the following applies.

Applicants' election of group I without traverse is acknowledged but contrary to what applicants state, there is considerable nonelected subject matter present in claims 1 and 2. It appears that the further restriction of group I has been overlooked. On p.5-6 of the previous action based on species elected, the examiner further restricted Group I to **compounds of formula IA** where Ar is the first 4 choices recited in claims 1 and where Q ring system only contains 1 N in the ring and is 6-membered as depicted in formula 1A. Thus W1 and W2 each can contain only 1 carbon atom as ring member. The restriction was based on the many diverse classifications present for the varying Q and Ar choices which would also necessitate more than one electronic structure search.

Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Reason #2 of the previous action remains. The thrust of the rejection was "oxo" as a choice for "aryl/heteroaryl" rings originally present in claim 1. Note on p.4, 12th line of claim 1 is where "oxo" should be deleted. Applicants' proviso excluding oxo on Q ring system literally excludes elected species as well as remaining species in claim 3 and thus should be deleted or reworded to permit

“oxo” on the Q ring consistent with original claim 1, which permits one (**and only one**) oxo .

Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The quinolinone species are no within the scope of claim 1 in view of the new proviso deleting such as discussed in the above 112 rejection.

Claim 2 is objected to because of the following informalities: It is noted that a typo exists since R9 and R10 were inadvertently not listed along with R1, R5-8 in this claim. Compare with specification on p.3. Appropriate correction is required.

Claims 2,4,5 and 7 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Contrary to what applicants state in their response, heteroaryl and heteroarylalkyl still remains within claim 2 and thus remains rejected for set forth in the previous response.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (EP'435) for reasons of record. Applicants' response to this rejection is not at all persuasive. The color photographs presented showing the 2-oxo groups in position isomers pairs of instant and Howard's compounds to have "differing spatial orientation" and thus not expected to have similar profiles of biological activity is made without any substantive comparative data showing differing activity. It is expected that nonidentical compounds will have differing spatial arrangements. Clearly the many cases directed to position isomerism are with compounds that do have differing orientations in space and yet claims were refused without evidence of patentable distinction. The fact remains there is a legal presumption that compounds such as position isomers are expected to have similar activities and it is applicants' burden to prove otherwise. In the instant case many species were pointed out that only differ in being position isomers and are taught for the same activity. Obviousness only requires a reasonable expectation of success not absolute predictability as set forth in *In re O'Farrell* 7 USPQ 2d 1673.

Counsel for applicants has stated that 10/660,908 (i.e.US'230) were commonly owned at the time the instant invention was made and thus Andreanna is withdrawn under 35 USC 103.

Claims 1-8 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/660908 for reasons of record. Applicants do not traverse this rejection but only indicate that a terminal disclaimer will not be filed at this time. PTO records indicate that the copending case is still pending.


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


Emily Bernhardt
Primary Examiner
Art Unit 1624